

REMARKS

Claims 1-19 were originally filed are currently pending in the present application.

Claims 11-19 were rejected in the November 6, 2006 Office Action.

No claims have been allowed.

Claims 1, 6, and 11 have been amended to add a limitation previously found in respective dependent claims 4, 9, and 13, which are now cancelled.

Reconsideration of the claims is respectfully requested.

The Examiner is thanked for noting the “double period” informality in Claim 11. This has been corrected.

CLAIM REJECTIONS -- 35 U.S.C. § 112

Claims 11-19 were rejected under 35 U.S.C. § 112, first paragraph as claiming subject matter that is not described in the specification in a manner enabling one skilled in the relevant art to make or use the claimed invention. This rejection is respectfully traversed.

Any analysis of whether a particular claim is supported by the disclosure in an application requires a determination of whether that disclosure, when filed, contained sufficient information regarding the subject matter of the claims as to enable one skilled in the pertinent art to make and use the claimed invention. MPEP § 2164.01, p. 2100-193 (8th ed., rev. 4, October 2005). The test of enablement is whether one reasonably skilled in the art could make or use the invention from the disclosures in the patent coupled with information known in the art without undue experimentation.

Id. A patent need not teach, and preferably omits, what is well known in the art. *Id.* The Patent

Office has the initial burden of establishing a reasonable basis to question the enablement provided for the claimed invention. MPEP § 2164.04 at 2100-197. The minimal requirement for a proper enablement rejection is to give reasons for the uncertainty of the enablement. *Id.*

The specific language rejected by the Examiner of claim 11 is:

performing a hard handoff for the mobile station between the transition base transceiver station and a second base transceiver station in the second wireless network, the transition base transceiver station located in proximity to the second base transceiver station, without performing an intervening hard handoff between the first base transceiver station and the transition base transceiver station.

Paragraph 12 of the specification as filed describes (emphasis added):

Therefore, a handoff is accomplished between the base transceiver station in the first wireless network and the base transceiver station in the second wireless network, with the only hard handoff performed being between the transition base transceiver station and the base transceiver station in the second wireless network. Accordingly, the hard handoff is performed between base transceiver stations in proximity to each other, resulting in a reliable hard handoff.

This description clearly supports the language of the claim. As this language describes “the only hard handoff” in this embodiment, is it clear that the applicant, at the time of the invention, had possession of the concept that there is no “intervening hard handoff between the first base transceiver station and the transition base transceiver station”, as claimed.

The Examiner further complains of a negative limitation. First, the Examiner incorrectly refers to a single phrase of the entire limitation, which is

performing a hard handoff for the mobile station between the transition base transceiver station and a second base transceiver station in the second wireless network, the transition base transceiver station located in proximity to the second base transceiver station, without performing an intervening hard handoff between the first base transceiver station and the transition base transceiver station.

As such, this is clearly a positive limitation to performing a hard handoff, after a positive limitation to performing a soft handoff, with a clause defining the manner in which the two steps are related – without an intervening hard handoff as described.

Moreover, MPEP 2173.05(i) is quite clear that negative limitations are proper:

The current view of the courts is that there is nothing inherently ambiguous or uncertain about a negative limitation. So long as the boundaries of the patent protection sought are set forth definitely, albeit negatively, the claim complies with the requirements of 35 U.S.C. 112, second paragraph.

This MPEP section goes on to distinguish the *Schechter* case on which the Examiner relies as one of some “older cases” that do not comport with the current view of the courts. Claim 11 and its dependents are clear and definite to those of skill in the art, and these rejections are traversed.

Accordingly, the Applicant respectfully requests the Examiner to withdraw the § 112 rejection.

CLAIM REJECTIONS

Claims 1-4, 6-9, and 11-14 were rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 6,011,971 to *Jolma*, hereinafter “*Jolma*.⁵” Claims 5, 10, and 15-19 were rejected under 35 U.S.C. § 103(a) as being unpatentable over *Jolma*. The Applicant respectfully traverses the rejection.

Independent claims 1, 6, and 11 have been amended to add a limitation previously found in respective dependent claims 4, 9, and 13 (now cancelled), specifying that the hard handoff is performed when the mobile station reaches a border for a hard handoff region, the hard handoff region a portion of the second wireless network. This limitation is not taught or suggested by the art of record.

The Examiner indicates, with relation to these limitations, a reliance on *Jolma*’s col.5, lines 35-39 and 50-53:

The cell 41 is served by two overlapping base stations, BTS11 and BTS21. BTS11 is coupled to base station controller BSC1, and BTS21 is coupled to base station controller BSC2. ... The terminal equipment carries out a hard handover from the base station BTS11 to the base station BTS21, and consequently, the base station controller change from BSC1 to BSC2 takes place.

It is clear that these passages have nothing at all to do with a border of the hard handoff region. *Jolma* does not define or describe a “hard handoff region”, as claimed, or that it is a portion of the second wireless network, or that the hard handoff is performed when it the mobile station reaches a border of the hard handoff region. Accordingly, the Applicant respectfully requests the Examiner to withdraw the § 102 and § 103 rejections with respect to all claims.

SUMMARY

For the reasons given above, the Applicant respectfully requests reconsideration and allowance of the pending claims and that this application be passed to issue. If any outstanding issues remain, or if the Examiner has any further suggestions for expediting allowance of this application, the Applicant respectfully invites the Examiner to contact the undersigned at the telephone number indicated below or at *jmockler@munckbutrus.com*.

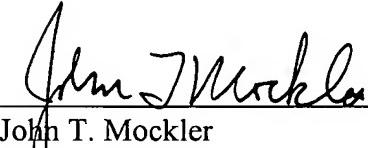
The Commissioner is hereby authorized to charge any additional fees connected with this communication or credit any overpayment to Deposit Account No. 50-0208.

Respectfully submitted,

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